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Appeal Brief
SDavis
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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Wayne Edward Beimesch

Examiner: David A. Rogers

Serial No. 09/806,274

Group Art Unit: 2856

Filed: March 27, 2001

For: METHOD FOR MEASURING
VOLATILE ORGANIC COMPOUNDS
AND A KIT FOR SAME

Mail Stop: Appeal Brief-Patent
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 CFR §1.192)

This appeal brief is in furtherance of the Notice of Appeal filed on December 24, 2002, in the above-identified patent application. Appellant hereby petitions for a three month extension of time under 37 C.F.R. § 1.136(a)(1). Appellant maintains the Appeal Brief has been timely filed pursuant to 37 C.F.R. §1.8 and §1.10.

This brief is transmitted in triplicate pursuant to 37 C.F.R. § 1.192(a).

This is an appeal of the final rejection of Claims 1-10 in the Advisory Action mailed on October 24, 2002.

I. REAL PARTY IN INTEREST

Midwest Research Institute is the real party in interest of the instant appeal.

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals and interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences known to Appellant, Appellant's legal representative, or assignee.

III. STATUS OF CLAIMS

Claims 1-10 were finally rejected in a final Office action mailed October 24, 2002.

Claims 1-10 are pending in the present application. All of these pending claims are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

An amendment after final dated December 24, 2002 was filed by Appellant, as was the Notice of Appeal. Such amendment was entered, as evidenced by the Advisory Action mailed January 29, 2003.

V. SUMMARY OF THE INVENTION

All references to page numbers refer to the Appellant's specification. Appellant's invention relates to the discovery of methods for measuring volatile organic compounds of a material produced in a process system having emissions, as further defined by the specification and Claims. Appellant's specification specifically further defines the invention at least on pages 1-2.

VI. ISSUES

The Examiner has rejected Claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,140,845 to Robbins. In addition, Claims 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,930,906 to Hemphill. Appellant maintains the Examiner has erred in rejecting Claims 1-7 and Claims 8-10 under 35 U.S.C. § 103(a).

VII. GROUPING OF CLAIMS

With regard to the rejection of Claims 1-10, it is submitted that Claims 1-7 stand or fall together and Claims 8-10 stand or fall together. Claims 1-7 are directed to a method of measuring volatile organic compounds of a material produced in a process system having emissions. Claims 8-10 are directed to a kit for measuring the volatile organic compounds of a material produced in a process system having emissions. As a method for measuring volatile organic compounds and kits for use in same, and as further evidenced by the separate pending rejections of these two claim sets, Appellant maintains that these two claim sets relate to separately patentable inventions.

VIII. ARGUMENT - REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner erred in contending that Claims 1-7 and Claims 8-10 are unpatentable under 35 U.S.C. § 103(a) over Robbins and Hemphill, respectively.

Claims 1-7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Robbins. Appellant's invention teaches a method for measuring volatile organic compounds (VOCs) of material produced in a process system having emissions. Examples of process systems in which this method may be utilized are provided in Appellant's specification at least on page 4, and include spray dryers, mixers, fluid bed dryers and coolers, and storage tanks. All of these systems are closed systems, and as such have dynamic air flow properties. Appellant maintains that Appellant's claims must be read in light of the specification.

Robbins teaches a method for measuring the volatile constituent of a **sample of ground water or soil mixed with water**. The systems generating the sample to be measured as described in Robbins are open systems, or in other words, systems open to the atmosphere, not the closed systems of Appellant's invention. While Robbins measures the volatile constituent in the sample of ground water or soil in a closed system by virtue of measuring the contents of the sample of ground water or soil so collected in a bag, Robbins does not teach or suggest the generation or measurement of volatile constituents produced in a **process system having emissions** as described in Appellant's invention. Specifically, the leakage of underground storage tanks and the testing of the contaminated soil resulting therefrom as described in Robbins is an open system, and does not teach or suggest the measurement of VOCs generated in the closed systems of Appellant's invention. The Examiner's logic in this regard would render obvious any and all measurements of volatile constituents generated in any system. Robbins therefore does not support the obviousness rejection of Appellant's invention. There is no teaching or suggestion of a method for measuring volatile organic compounds (VOCs) of material produced in a **process system having emissions** as claimed and provided by way of Appellant's invention. A *prima facie* case of obviousness has not been established.

Claims 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,930,906 to Hemphill. Appellant notes that the Examiner's statement in the Office

Action dated October 24, 2002, pertaining to the "anticipation" of Appellant's invention by Hemphill is misplaced. The rejection of record at this time is an obviousness rejection over the Hemphill reference. As so stated, the Examiner refers to an "anticipation" rejection. This is clearly in error.

Hemphill teaches a cooking grease disposal bag. Hemphill does not teach or suggest a kit for measuring volatile organic compounds produced in a **process system having emissions** as provided by way of Appellant's invention. Further, Hemphill does not teach or suggest process systems having emissions, nor does Hemphill teach or suggest volatile organic compounds being emitted **in any system**. Appellant maintains the current rejection of Claims 8-10 over Hemphill is analogous to making an obviousness rejection of Claims 8-10 over any resealable bag. There simply is no teaching or suggestion in Hemphill of Appellant's kit for measuring VOCs in a **process system having emissions** as claimed. A *prima facie* case of obviousness has not been established.

Appellant respectfully requests the Honorable Board of Appeals reverse the Examiner in the rejections of Claims 1-7 and Claims 8-10 under 35 U.S.C. § 103(a). Appellant respectfully solicits allowance of Claims 1-10, all of the Claims appealed and pending in the instant application.

Respectfully submitted,

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APPENDIX OF THE CLAIMS ON APPEAL

1. A method for measuring volatile organic compounds of a material produced in a process system having emissions, said method comprising:
 - (a) disposing an amount of said material in an enclosed bag having a sealable opening such that there is headspace above said material in said enclosed bag;
 - (b) storing said enclosed bag containing said solid material at the mean exit temperature of said emissions of said system such that equilibrium between said material and said headspace is reached; and
 - (c) introducing samples from said headspace into a flame ionization detector which thereby measures said volatile organic compounds of said material.
2. The method of claim 1 wherein said system is a fluid bed dryer.
3. The method of claim 1 wherein said system is a spray dryer.
4. The method of claim 1 wherein said storing step is for from about 5 hours to about 24 hours.
5. The method of claim 1 wherein said amount of said material is from about 1 gram to about 100 grams.
6. The method of claim 1 wherein said system is a storage tank.
7. The method of claim 1 wherein said mean exit temperature is from about 5 °C to about 100 °C.
8. A kit for measuring the volatile organic compounds of a material produced in a process system having emissions, said kit comprising:
 - (a) an enclosed bag having a sealable opening to allow an amount of said material to be placed in said enclosed bag such that there is headspace above said material; and
 - (b) instructions for analyzing samples from said headspace in said enclosed bag, thereby providing said volatile organic compounds of said material.

9. The kit of claim 8 wherein said instructions for analyzing said samples include withdrawing said samples from said headspace using a flame ionization detector.

10. The kit of claim 8 wherein said instructions for analyzing samples include storing said enclosed bag in a temperature adjustable apparatus.